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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,828	06/23/2003	Guo Rui Deng	2451.PCRA.PT	9067

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EXAMINER

DEXTER, CLARK F

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/601,828	Applicant(s) DENG ET AL.	
	Examiner Clark F. Dexter	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2005.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,17-19 and 32-53 is/are pending in the application.
4a) Of the above claim(s) 1-53 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,17-19,32,36,40 and 43-50 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 17 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 14, 2005 has been entered.

Claim Objections

2. Claims 40-46 and 49 are objected to because it is respectfully submitted that applicant did not follow the current rules for amending the claims. Specifically, in claim 40, line 4, the claim does not show the deleted recitation "~~base portion~~"; in claim 49, line 2, the claim does not show the deleted recitation "~~has a thickness~~".

To expedite prosecution, these claims have been considered. However, care should be taken to amend the claims according to the current rules in response to this and subsequent Office actions.

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 18, 19, 40, 45-47 and 49 are rejected under 35 U.S.C. 102(b) as anticipated by Sarka et al., pn 3,863,550 or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sarka et al., pn 3,863,550 in view of Beroz et al., pn 6,543,131.

Sarka discloses an apparatus (e.g., in Fig. 11) with every structural limitation of the claimed invention including at least one metal base portion/metal plate (e.g., 2), at least one metal blade (e.g., 15) having at least one exposed cutting edge (e.g., 17), and a covering/housing/adapter (e.g., 21, 22). Further, Sarka meets the newly added

limitation of a covering "affixed to" the at least one metal base portion (claims 1 and 47) and a housing "affixed to" the metal plate (claim 40) in that when the plastic filler material is injected to fill the space and then cured as described (e.g., see col. 4, lines 2-13), the inner assembly will become stuck or held in place within the fixture and thus "affixed to" the fixture, whereby a force will be necessary to remove the assembly from the fixture.

In the alternative, if it is argued that there is no explicit disclosure that the assembly will become affixed to the fixture, it would have been obvious to one having ordinary skill in the art to use adhesive (e.g., two-sided adhesive tape or a mass of adhesive material) to affix the assembly, particularly plate 2, in the fixture to facilitate assembly of the die disclosed in Sarka. One having ordinary skill in the art would be very familiar with the use of such adhesive in the assembly arts and know that it is often applied to assist in assembling of components; for example, such adhesive would be applied between the bottom plate 2 and the bottom 21 of the molding fixture to maintain the respective positions of the die components and the molding fixture during assembly, whereby after assembly, the die would be removed from the molding fixture and the adhesive removed. Beroz discloses one example of the use of such an adhesive to temporarily hold components in place during assembly (e.g., see Figs. 9, 10 and col. 7, lines 23-27; col. 15, lines 26-33). Therefore, it would have been obvious to one having ordinary skill in the art to attach the covering to the metal base portion in Sarka for at least the benefits described above.

Claim Rejections - 35 USC § 103

6. Claims 17, 43, 44 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarka et al., pn 3,863,550 in view of Beroz et al., pn 6,543,131.

Sarka discloses an apparatus (e.g., in Fig. 11) with almost every structural limitation of the claimed invention but lacks the covering/housing/adapter being made of a material softer than the metal plate, specifically plastic. However, it is old and well known in the art that plastic provides various well known benefits including an inexpensive, light weight material that is easy to manufacture and handle. Further, it has been held that the selection of a known material on the basis of suitability for the intended use would be entirely obvious (see *In re Leshin*, 125 USPQ 416 (CCPA 1960)). Therefore, it would have been obvious to one having ordinary skill in the art to make the molding fixture disclosed in Sarka from plastic to gain the well known benefits including those described above.

7. Claims 32 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarka et al., pn 3,863,550 in view of Beroz et al., pn 6,543,131.

Sarka discloses an apparatus (e.g., in Fig. 11) with almost every structural limitation of the claimed invention but lacks adhesive attaching the covering to the metal base portion. However, it would have been obvious to one having ordinary skill in the art to use adhesive (e.g., two-sided adhesive tape or a mass of adhesive material) to affix the assembly, particularly plate 2, in the fixture to facilitate assembly of the die disclosed in Sarka. One having ordinary skill in the art would be very familiar with the use of such adhesive in the assembly arts and know that it is often applied to assist in

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assembling of components; for example, such adhesive would be applied between the bottom plate 2 and the bottom 21 of the molding fixture to maintain the respective positions of the die components and the molding fixture during assembly, whereby after assembly, the die would be removed from the molding fixture and the adhesive removed. Beroz discloses one example of the use of such an adhesive to temporarily hold components in place during assembly (e.g., see Figs. 9, 10 and col. 7, lines 23-27; col. 15, lines 26-33). Therefore, it would have been obvious to one having ordinary skill in the art to attach the covering to the metal base portion in Sarka for at least the benefits described above.

8. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sarka et al., pn 3,863,550 in view of Johnson, pn 6,658,978.

Sarka discloses an apparatus (e.g., in Fig. 11) with almost every structural limitation of the claimed invention but lacks the at least one metal base portion and the blade being welded together. However, it is old and well known in the art to weld a blade to a metal base portion, particularly in die structures, as being one of many known ways to provide a secure connection therebetween. Welding provides various well known advantages; for example, it is relatively inexpensive and tooling to perform such tasks is readily available. Johnson (e.g., Fig. 4) provides one example of such welding. Therefore, it would have been obvious to one having ordinary skill in the art to weld the at least one metal base portion and the blade being together for the well known benefits including those described above.

Response to Arguments

9. Applicant's arguments filed November 14, 2005 have been fully considered but they are not persuasive.

In the second paragraph on page 13 of the response, applicant argues that

“It is clear from the description that elements 21 and 22 are not part of the cutting die and scoring die disclosed in the Sarka et al. reference and are clearly not “affixed” thereto.”

First, it is respectfully submitted that applicant has not pointed to any location in the disclosure of Sarka wherein it is stated that the subject components are not affixed to one another. Merely because the components are described as being separable does not provide sufficient evidence that the components are not affixed before they are separated, particularly after undergoing the disclosed injection and curing procedures. The newly added limitation has been further addressed in the prior art rejection above.

Second, applicant argues that elements 21 and 22 are not part of the cutting die and scoring die as disclosed. However, it is respectfully submitted that applicant appears to be arguing an intended use to distinguish the claimed invention over the prior art, and has not pointed out specific structural differences between the claimed invention and the applied prior art. As applicant is well aware, a functional recitation of intended use cannot be relied upon to distinguish the claimed invention over the prior art. It is further submitted that the Examiner's position is not that the components are used in the same manner or for the same purpose. Rather, the Examiner's position is

that Sarka et al. discloses or suggests (as described in the rejection above) every structural limitation of the claimed invention.

In the second paragraph on page 13 of the response, applicant argues that

“Again, as previously discussed herein, the applicants respectfully submit that Sarka et al. fails to teach or suggest the ‘covering’ or ‘housing’ as claimed in the pending claims.”

Again, it is respectfully submitted that applicant appears to be arguing an intended use to distinguish the claimed invention over the prior art, and has not pointed out specific structural differences between the claimed invention and the applied prior art. And, as applicant is well aware, a functional recitation of intended use cannot be relied upon to distinguish the claimed invention over the prior art.

Regarding applicant’s argument in the last paragraph on page 15 of the response, it is respectfully submitted that this argument is fully addressed in the prior art rejection above.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Allan N. Shoap can be reached on (571)272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Clark F. Dexter
Primary Examiner
Art Unit 3724

cfd
February 21, 2006